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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/701,893

12/01/2000

Dennis Bigg

427 038

9852

20311

7590

04/26/2005

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NEW YORK, NY 10016

EXAMINER

COLEMAN, BRENDA LIBBY

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/701,893

Applicant(s)

BIGG ET AL.

Examiner

Brenda L. Coleman

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3,9,10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9,10,12 and 13 is/are rejected.
- 7) ☒ Claim(s) 3 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Claims 3, 9, 10 and 12-14 are pending in the application.

This action is in response to applicants' amendment filed February 28, 2005.

Claims 4 and 11 have been canceled and claim 14 is newly added.

### *Response to Arguments*

Applicants' arguments filed February 28, 2005 have been fully considered with the following effect:

1. The applicants amendments and remarks are sufficient to overcome the 35 U.S.C. § 102, anticipation rejection labeled paragraph 4) and 8) maintained in the last office action, which are hereby **withdrawn**.
2. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled b), f), i) and x) maintained in the last office action, which are hereby **withdrawn**.
3. The applicants amendments and remarks are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of claim 11 by Okana et al., EP 0 367 110 maintained in the last office action, which is hereby **withdrawn**.
4. The applicants amendments and remarks are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of claim 11 by Braquet et al., FR 2 660 311 maintained in the last office action, which is hereby **withdrawn**.

5. The applicants amendments and remarks are sufficient to overcome the 35 U.S.C. § 103, obviousness rejection of claim 11 by Weber et al., EP 0 503 471 maintained in the last office action, which is hereby **withdrawn**.

6. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejections labeled paragraph 8) in the last office action, which is hereby **withdrawn**.

7. The applicant's amendments and arguments are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejections labeled paragraph 9) in the last office action, which are hereby **withdrawn**.

8. The applicant's amendments and arguments are sufficient to overcome the objection of claims 4 and 9-12 labeled paragraph 10a), b), d) and e) of the last office action, which are hereby **withdrawn**. However, with regards to the objection of claims 4 and 9-12 labeled paragraph 10c), in the last office action, the applicant's amendments and remarks have been fully considered but they are not persuasive.

c) The applicants indicate, "this was believed to be properly supplied in the last response". However, the rejection labeled paragraph c) is on the basis that there is no point of attachment on the moiety  $-\text{SO}_2$ , where one of the points of attachment is indicated, but the other is not as shown by the other moieties in the definition of  $\text{Z}_{32}$ , i.e.  $-\text{C}(\text{O})-$ ,  $-\text{S}(\text{O})-$  and  $-\text{O}-\text{CO}-$ .

Claims 9 and 10 are objected to for reasons of record and stated above.

In view of the amendment dated February 28, 2005, the following new grounds of rejection apply:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the invention, at the time the application was filed, had possession of the claimed invention. The last species in claim 14 where R'<sub>1</sub> is 4-Cl; R<sub>2a</sub>' is H; R<sub>2b</sub>' is H; and R'<sub>3</sub> is pentyl is not described in the specification.

Applicant is required to cancel the new matter in the reply to this Office action.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

10. Claims 9, 10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

a) Claims 9, 10 and 12 are vague and indefinite in that it is not known what is meant by the definition of X, which is missing a bond to indicate the point of attachment as is shown by the moiety  $-(CH_2)_n-Z$ .

- b) Claims 9, 10 and 12 are vague and indefinite in that it is not known what is meant by the definition of  $R_3$ , which is missing a bond between the  $Z_{32}$  and  $R_{34}$  as is shown by the moiety  $-Z_{32} R_{34}$ .
- c) Claim 10 is vague and indefinite in that it is not known what is meant by the second occurrence of the following which appears at the end of page 5 and again on the top of page 6: substituted heteroaryl, unsubstituted or substituted heteroarylalkyl and  $-Z_{31}R_{31}$ , the substituents being selected from the group consisting of halogen, aryl.

### ***Claim Objections***

11. Claims 3 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda L. Coleman whose telephone number is 571-272-0665. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Brenda L. Coleman  
Primary Examiner Art Unit 1624  
April 22, 2005